

### **REMARKS**

Applicant thanks the Examiner for total consideration given the present application. Claims 3-6 and 8-15 are currently pending.

The amendments to claims 3 and 4 are editorial in nature. Claims 3 and 4 have been amended to include "a program clock reference (PCR)" instead of "said PCR" in order to correct lack of antecedent basis. Applicant respectfully submits that these amendments are not narrowing and are not made for reasons relating to patentability. Accordingly, it is submitted that these amendments do not give rise to estoppel and in future analysis claims 3 and 4 are entitled to their full range of equivalence.

### **ALLOWABLE SUBJECT MATTER**

Applicant thanks the Examiner for allowing claims 5, 6, 8, and 13-15. For the reasons discussed below, Applicant now believes that all pending claims are in condition for allowance and earnestly solicit an early indication thereof in the form of a Notice of Allowance.

### **REJECTION UNDER 35 U.S.C. § 102**

Claims 3 and 4 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Nagata et al. (US 6,643,449). This rejection is respectfully traversed.

Initially, Applicant wishes to point out that MPEP § 2131 sets forth the following:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claims." *Richardson v. Suzuki Motor Co.*, 868 F2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

It is respectfully submitted that Nagata does not set forth each and every element as defined in the claims.

Specifically, independent claims 3 and 4 recite, *inter alia*, a parameter set portion configured to detect content change of information table on the basis of a predetermined criterion and to set a program parameter, described in the information table, that has changed as a signal extraction parameter upon detecting the content change, wherein . . . the predetermined criterion includes presence/absence of discontinuity of a program clock reference (PCR) (claim 3) or whether or not the PCR is unreceivable for a predetermined time (claim 4).

Conversely, Nagata is directed to a recording/reproducing apparatus comprising a demultiplexing/Group of picture (GOP) head detecting section to detect a Program Clock Reference (PCR) value and a recording/reproduction control section 29 to record a video or audio packet in a bit stream file and to record information on the number of packets every PCR value and GOP (Abstract). Nagata merely teaches that a recording/reproducing control section 29 sets various modes including a recording mode, reproducing mode and a time shift reproducing mode based on operational signals and controls a demultiplexing/Group of picture (GOP) head detecting section 22 and a recording device 26. The demultiplexing/GOP head detecting section 22 outputs to the recording device 26, a Program Clock Reference (PCR) value at a GOP head timing (col. 5, lines 4-20). The recording device 26 stores information either as a bit stream file 28 or as a table file 27, wherein the bit stream file 28 only stores a desired program of a Packet Identification (PID) a user designates and the table file 27 includes time information on the GOP head timing and information on the number of GOP packets or bits (col. 5, lines 44-62).

However, Nagata is silent on whether the recording/reproducing control section 29 or the recording device 26 is configured to **detect change of the information table on the basis of a predetermined criterion and to set a program parameter, described in the information table, that has changed as the signal extraction parameter upon detecting the content change** as recited in claims 3 and 4.

In addition, the Examiner contends that “the recording/reproducing control section 29 monitors and detects a discontinuity of the PCR . . . [t]he act of detecting a discontinuity of the

PCR corresponds to the claimed detecting presence/absence of discontinuity of the PCR.”<sup>1</sup> Applicant respectfully submits that the Examiner’s contention is erroneous. Nagata teaches that when a discontinuity indicator for a packet including PCR comes to 1 during the GOP period, or when the PID to be demultiplexed by an operational signal such as a user channel switching signal is altered so that the PCR value becomes discontinuous, the PCR at that time is written in the table file 27 (col. 7, lines 50-59).

Nagata, however, fails to teach that the recording/reproducing control section 29 is configured to detect content change of the information table 27 on the basis of a predetermined criterion while **the predetermined criterion includes presence/absence of discontinuity of the PCR as required by claim 3 or whether or not the PCR is unreceivable for a predetermined time as required by claim 4.**

Thus, Nagata fails to teach the above-mentioned features in claims 3 and 4. At least for the reasons set forth above, it is respectfully submitted that claims 3 and 4 are allowable over Nagata.

### **REJECTION UNDER 35 U.S.C. § 103**

Claims 9 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagata et al. (US 6,643,449) in view of the Applicant's admitted prior art (APA). This rejection is respectfully traversed.

Assuming for the sake of argument that there is sufficient motivation to combine Nagata and APA, Applicant respectfully submits that such a combination fails to teach or suggest all of the feature in the claimed invention. Thus, the Examiner has failed to satisfy the requirements of MPEP § 2143.03 which states:

---

<sup>1</sup> See Office Action, page 3.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Specifically, independent claims 9 and 10 recite, *inter alia*, a parameter set portion configured to detect content change of information table on the basis of a predetermined criterion and to set a program parameter, described in the information table, that has changed as a signal extraction parameter upon detecting the content change; a recording/reproducing portion . . . comprising a discontinuity flag adding part for adding a discontinuity flag to externally received digital broadcast signal when the recording/reproducing part stops recording the externally received digital broadcast signal and making the recording/reproducing part record the externally received digital broadcast signal which the discontinuity flag is added as the digital broadcast signal for reproduction, . . . while the predetermined criterion includes presence/absence of the discontinuity flag. These features are not taught nor suggested by the proposed Nagata/APA combination.

As argued above with respect to claims 3 and 4, Nagata is silent on whether the recording/reproducing control section 29 or the recording device 26 is configured to detect change of the information table on the basis of a predetermined criterion and to set a program parameter, described in the information table, that has changed as the signal extraction parameter upon detecting the content change. In addition, the Examiner admits that the recording/reproducing control section 29 of Nagata fails to teach a discontinuity flag adding part for adding a discontinuity flag to externally received digital broadcast signal in accordance with the claim scope mentioned above.

In an attempt to make up for the deficiencies noted above in Nagata, the Examiner imports APA to contend that the combined invention teaches a discontinuity flag adding part for adding a discontinuity flag to externally received digital broadcast signal in accordance with the claim scope mentioned above.

The Examiner's application of APA teaches these features is clearly in error. APA teaches a conventional digital broadcast receiving system including a discontinuity information generator 125 which simply detects whether a demodulated signal obtained from a receiving/demodulating part 111 is discontinuous (see page 1, lines 8-23 of the specification). **APA fails to teach that the discontinuity information generator 125 includes a flag adding part for adding a discontinuity flag to externally received digital broadcast signal when the recording/reproducing part stops recording the externally received digital broadcast signal and making the recording/reproducing part record the externally received digital broadcast signal which the discontinuity flag is added as the digital broadcast signal for reproduction as required by claims 9 and 10. Furthermore, neither Nagata nor APA teaches that the predetermined criterion includes presence/absence of the discontinuity flag.**

At least for the reasons set forth above, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness. Thus, Applicant submits that independent claims 9 and 10 are allowable over the combination of Nagata and APA.

Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nagata et al. (US 6,643,449). This rejection is respectfully traversed at least for the reasons set forth above with respect claims 3, 4, 9, and 10. In addition, it is respectfully submitted that **Nagata fails to teach an identification code adding portion configured to add an identification code identifiable in a program unit to an information table in the externally received digital broadcast signal** when the recording/reproducing part records the externally received digital signal and make the recording/reproducing portion record the externally received digital broadcast signal to which the identification code is added as the digital broadcast signal for reproduction. Applicant respectfully submits that the Examiner's reliance on the access means disclosed in Japanese Unexamined patent Publication No. 8-273296 mentioned in the Nagata patent (col. 19, lines 45-60) to cure the deficiencies mentioned above is erroneous. As acknowledged by the Examiner that the access means of the '296 publication merely provides for an ID to be given to each of frames of compressed and encoded video data to establish the corresponding relationship between the ID and the recorded position of the frame on a record

medium so that the position, on the record medium, of the frame to be accessed at a special reproduction can easily be specified. However, this above teaching lacks any support for **an identification code adding portion which is configured to add an identification code identifiable in a program unit to an information table** as specifically recited in claims 11 and 12. Furthermore, Nagata fails to teach the **predetermined criterion includes presence/absence of change of the identification code**.

At least for the reasons set forth above, it is respectfully submitted that claims 11 and 12 are allowable over Nagata. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

### **CONCLUSION**

In view of the above remarks, it is believed that the claims clearly distinguish over the patent relied on by Examiner either alone or in combination.

Should the Examiner have any questions regarding this matter, she is respectfully requested to contact Ali M. Imam (Reg. No. 58,755), who may be reached in the Washington, DC, area at (703) 205-8000.

Application No. 09/679,623  
Amendment dated September 14, 2006  
Reply to Office Action of June 23, 2006

Docket No.: 2257-0163P

If necessary, the Commissioner is hereby authorized in this concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Dated: September 14, 2006

Respectfully submitted,

By 

D. Richard Anderson

Registration No.: 40,439

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant